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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) F-281
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on <u>December 2, 2005</u></p> <p>Signature <u>Amy Harvey</u></p> <p>Typed or printed name <u>Amy Harvey</u></p>		Application Number 09/898,232 Filed 07/02/2001 First Named Inventor Uday W. Joshi Art Unit 3661 Examiner C. Nguyen

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- applicant/inventor.
- assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)
- attorney or agent of record. 43,748
Registration number _____
- attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____



Signature

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December 2, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

<input type="checkbox"/>	*Total of <u>1</u> forms are submitted.
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This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Claims 1, 2, 5, 9 and 18-19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Mori et al. (U.S. 5,982,994). Claims 3, 4, 6, 7 and 9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Mori et al. in view of Fabel (U.S. 6,209,779).

Claim 1 is directed to a method for generating a mailing that comprises “storing at a data center a design for each of a plurality of mail pieces, each of said designs being in a format viewable from a remote computer via a network; receiving, at said data center, an order for a plurality of pieces of a first mail piece design from said remote computer via said network; combining, using a processor at said data center, said order for said plurality of pieces of said first mail piece design with at least one other order for a plurality of pieces of a second mail piece design to produce a single print run; arranging, using said processor, said single print run in a presort sequence based on recipient addressing information for said plurality of pieces of said first and second mail piece design; printing each of said plurality of pieces of said first mail piece design and said plurality of pieces of said second mail piece design of said single print run in said arranged presort sequence on a corresponding print medium to produce a plurality of finished mail pieces in said presort sequence; and mailing said plurality of finished mail pieces.”

Mori et al., in contrast, is directed to a high-speed network printer apparatus that can be used in common by LAN terminals (clients) having different communication protocols. As shown in Fig. 1, the network printer apparatus 20 includes a printing mechanism 23 composed of a recording system and paper feeding system, a mailbox 51 provided with bins for accommodating printed paper so as to store printed paper in a designated bin, a client 52 and a communication path 53. The printing information is supplied from the client 52 through a connector 26 and received by a LAN interface driver 21b, which identifies the communication protocol. The communication protocol controller 21-3, 21-4, 21-5 or 21-6 corresponding to the identified communication protocol controls communication in accordance with the predetermined protocol and receives printing data. The spooling controller 21-8 stores the printing information in the hard disk 24 and creates a queue for printing jobs. The printer controller 22 reads out of the hard disk 24 the printing information corresponding to the printing job of the highest priority which the printing mechanism 23 prints the image on paper. If the mailbox 51 is provided, the mailbox controller 20a obtains the number of the bin which is to store the printed paper directly or indirectly from the printing information and stores the printed paper in the bin. (Col. 6, line 30 to Col. 7, line 4).

There is no disclosure, teaching or suggestion in Mori et al. of combining an order for a plurality of pieces of a first mail piece design with at least one other order for a plurality of pieces of a second mail piece design to produce a single print run as is recited in claim 1. In Mori et al., each print job from a separate client is handled separately based on a priority designated by the queue. The Office Action contends that Col. 18, lines 54-55, which refers to the ability of the user to select single-side or both side printing for a print job, discloses this feature. This is clearly incorrect. The selection made by the user to print on only one side of a paper or both sides of a paper for the user's print job is in no way related to combining the user's print job with another print job from a different user. There is no disclosure, teaching or suggestion in Mori et al. of combining said order for said plurality of pieces of said first mail piece design with at least one other order for a plurality of pieces of a second mail piece design to produce a single print run as is recited in claim 1.

There is also no disclosure, teaching or suggestion in Mori et al. of arranging the single print run in a presort sequence based on recipient addressing information as is recited in claim 1. The Office Action contends that "Mori et al. obviously suggest about arranging a single print run in a presort sequence - Mori et al. teach in the abstract that printing jobs can be sorted out into the order of clients." The Office Action appears to be equating the mailbox 51 of Mori et al. with arranging the print run in a presort sequence of the present invention. This is simply not correct. In Mori et al. a mailbox 51 is provided with a plurality of bins for accommodating discharged paper as a post-processing mechanism of the network printer apparatus. When a user requests a print job, the user can designate the number of the bin in the mailbox in which the printed paper will be stored for later retrieval by the user. Alternatively, there is a correspondence between a user name or a group name and a bin registered in the mailbox information management information in advance, so that designation of the bin in the mailbox for storing paper is not necessary at the time of requesting printing. (See Cols. 32-33). Thus, in Mori et al., each print job from a different user is kept separate from other user's print jobs by placing each different print job into a different bin. There is no combining of print jobs, nor is there any arranging of combined print jobs into a presort order based on recipient addressing information in Mori et al. This is in direct contrast with the present invention in which orders for a first and second mail piece design are combined into a single print run, arranged in a presort sequence based on addressing information for the mail pieces, and printed in the arranged presort sequence. There is simply no disclosure, teaching or suggestion of any of these features in Mori et al.

There is also no disclosure, teaching or suggestion in Mori et al. of storing at a data center a design for each of a plurality of mail pieces as is recited in claim 1. In Mori et al., all of the printing information is supplied from the client, i.e., the workstation that generated the documents to be printed. There is, therefore, no storage of any types of designs for mail pieces in Mori et al. The Office Action contends that the hard disk 24 of Mori et al. can do the above claimed function. Claim 1 recites “storing at a data center a design for each of a plurality of mail pieces, each of said designs being in a format viewable from a remote computer via a network.” The hard disk 24 in Mori et al. is located in a network printer apparatus 20 for storing printing information corresponding to print jobs that are subsequently read out and printed. A network printer apparatus, i.e., a printer, is not the same as a data center. Furthermore, storing printing information about print jobs sent to the printer is not the same as storing a design for each of a plurality of mail pieces, each of said designs being in a format viewable from a remote computer via a network as is recited in claim 1.

In the Advisory Action mailed on Nov. 23, 2005, it is stated that the “Cited prior art inherently suggest steps of combine different printings/(orders), arranging/command to print in an order (based on address/amount/name/receiving order . .).” Applicants first wish to note that the Advisory Action is the first instance where the Examiner is claiming that the limitations of the pending claims are inherently suggested in Mori et al. (as opposed to all preceding Office Actions which contend that the limitations are obvious in view of Mori et al.), and thus this would appear to be improper in an Advisory Action. To facilitate prosecution, however, a response to the inherency contention is being provided.

“To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

As noted above, there is no disclosure, teaching or suggestion in Mori et al. of combining an order for a plurality of pieces of a first mail piece design with at least one other order for a plurality of pieces of a second mail piece design to produce a single print run, or arranging the

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single print run in a presort sequence based on recipient addressing information as is recited in claim 1. Nor are such limitations inherent in Mori et al. In Mori et al., each print job from a separate client is handled separately based on a priority designated by the queue. The selection made by the user to print on only one side of a paper or both sides of a paper for the user's print job is in no way related to combining the user's print job with another print job from a different user. Furthermore, in Mori et al., each print job from a different user is kept separate from other user's print jobs by placing each different print job into a different bin. There is no combining of print jobs, nor is there any arranging of combined print jobs into a presort order based on recipient addressing information in Mori et al. The Advisory Action has not provided any basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of Mori et al.

The reference to Fabel does not cure any of the above deficiencies, as it was relied upon for other features.

For at least the above reasons, Applicants respectfully submit that claim 1 is allowable over the prior art of record. Claims 2-7 and 9, dependent upon claim 1, are allowable along with claim 1 and on their own merits.

Claim 18 includes limitations substantially similar to those of claim 1. For the same reasons given above with respect to claim 1, Applicants respectfully submit that claim 18 is allowable over the prior art of record.

Claim 19, dependent upon claim 18, is allowable along with claim 18 and on its own merits.